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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/928,767   | 08/13/2001  | Khushrav S. Chhor    | 5732-00100 MD-080   | 7633             |
| 35617  | 7590        | 10/06/2003           | EXAMINER            |                  |
| CONLEY ROSE, P.C.<br>P.O. BOX 684908<br>AUSTIN, TX 78768 |             |                      | FUREMAN, JARED      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2876                |                  |

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/928,767

Applicant(s)

CHHOR ET AL.

Examiner

Jared J. Fureman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "16" (see page 3 line 12, of the specification) and "46" (see page 11 line 5, of the specification). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see the description of figures 1 and 2, under "Description of the Related Art", pages 1-5 of the specification). See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The abstract of the disclosure is objected to because the abstract is greater than 150 words. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities:  
Page 3, line 9: "Fig. 1 illustrates" should be replaced with --Figs. 1 and 2 illustrate--, since reference number 12 (mentioned at page 3 line 10 of the specification) is shown in figure 2, not figure 1.

Page 9, line 20: "the integrated circuit of Fig. 4" should be replaced with --an integrated circuit--.

Appropriate correction is required.

### ***Claim Objections***

5. Claim 6 is objected to because of the following informalities: Claim 6, line 1: --the-- should be inserted after "wherein". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6, 11, 21, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwasaki (US 6,274,926 B1, hereinafter Iwasaki '926).

Re claims 1-6 and 11: Iwasaki '926 teaches a memory module (1), comprising: a plurality of conductors (terminals 5), each of which have opposed first and second ends (as shown in figure 2); an integrated circuit (2) coupled to the first end of each of the plurality of conductors (see figure 2); and a molded resin (sealing resin 3) encasing the integrated circuit and having an outer surface on which the second end of each of the plurality of conductors terminate in a single row near an edge of the memory module

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(see the edge of the module 1 having conductors 5, shown in figure 1); wherein the edge of the memory module is adapted for slideable engagement into a receptor (7, see figures 5-7) that is electrically connected to an electronic system (not shown); wherein the second end of each of the plurality of conductors are adapted for frictional engagement with, and electrical connection to, conductive elements (8) arranged within the receptors, during times when the edge of the memory module is slid into the receptor; wherein the molded resin extends at least partially around the integrated circuit to form an entire outer dimension of the memory module; wherein the entire outer dimension of the memory module is of equivalent size to a memory card (in that device 1 is a memory card itself); wherein the memory module is mechanically and electrically interchangeable with a memory card (any device 1 may be interchangeable with another device 1); further comprising wires (4) extending between a plurality of bonding pads (not shown) on the integrated circuit and the first end of each of the plurality of conductors; (see figures 1-7, column 2 lines 17-29, column 2 line 52 - column 3 line 30, column 4 line 27 - column 6 line 62).

Re claims 21, 26, and 27: The teachings of Iwasaki '926 have been discussed above. Iwasaki '926 also teaches a method for forming a memory module (1), comprising: coupling an integrated circuit (2) to at least one of a plurality of conductors (5) extending in a single direction laterally from the integrated circuit along two planes substantially parallel with a plane formed by the integrated circuit; securing the plurality of conductors between a pair of mold housings (6b, 6c, 6d) (the mold 6 registers, engages, and arranges the terminals 5, see column 5 lines 8-11), each of which have a

cavity (the space present within the mold before resin 3 is injected) that surrounds opposed surfaces of the integrated circuit absent any structure between the coupled integrated circuit and the pair of mold housings (Iwasaki '926 teaches that supporting pieces are only used if required (see column 5 lines 11-14), thus teaching that it is possible to mold the memory module without any supporting structure, in some situations); and inserting resin (3) between the pair of mold housings; wherein said securing comprises suspending the integrated circuit within an air-filled space formed by the cavity of each of the mold housings by clamping the plurality of conductors between the pair of mold housings a spaced distance from the cavity (see figures 3 and 4); wherein said inserting resin comprises flowing the resin in liquid form into an air-filled space formed by the cavity of each of the mold housings and then allowing the resin to harden (see figures 1-7, column 2 lines 17-29, column 2 line 52 - column 3 line 30, column 4 line 27 - column 6 line 62).

8. Claims 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwasaki (US 6,085,412, cited by applicants, hereinafter Iwasaki '412).

Iwasaki '412 teaches a lead frame (metal frame 12) comprising a first portion (121) spaced from a second portion (122), wherein the first portion is configured to receive an integrated circuit (11a), and wherein the second portion is a conductor extending along a first plane co-planar to the first portion downward to a second plane on which a surface of the conductor is adapted to releasably secure against a receptor (a receptor, such as adaptor 90 shown in figure 15); a memory module (see figure 14) that encases the lead frame and the integrated circuit and extends to a surface co-

planar with the second plane; a molded resin that completely surrounds the integrated circuit and the first and second portions, except for the surface of the conductor that is adapted to releasably secure against the receptor (see figure 14 and column 7 lines 59-65); wherein the surface of the conductor extending to the second plane is exposed along an edge of the memory module (see figure 14); wherein an upper surface of the first portion is bonded to a lower surface of the integrated circuit (an upper surface of bed 121 is bonded to a bumps 112 on a surface of chip 11a, see figure 14); wherein the conductor (121) is coupled to a bonding pad (bumps 112) arranged upon an upper surface of the integrated circuit (the bumps 112 of the integrated circuit 11a can be interpreted to be on a lower or upper surface of the integrated circuit 11a, since this is merely a matter of perspective) (see figure 14 and column 7 lines 31-65).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 12, 14, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki '926 in view of the admitted prior art.

The teachings of Iwasaki '926 have been discussed above.

Iwasaki '926 fails to specifically teach the entire outer dimension of the memory module except for the second end of each of the plurality of conductors is surrounded by a covering that employs a mechanical tab which, when actuated, prevents writing

data to the integrated circuit; solder extending between a plurality of bonding pads on the integrated circuit and the first end of each of the plurality of conductors; and wherein the plurality of conductors comprise flattened metal strips attributed to a tape mounted upon a Tape Automated Bonding (TAB) device.

The admitted prior art teaches that it was well known to those of ordinary skill in the art at the time of the invention to surround the entire outer dimension of a memory module (10) except for a second end of each of a plurality of conductors (12) with a covering (36) that employs a mechanical tab (38) which, when actuated, prevents writing data to the integrated circuit (see figure 2 and page 4 lines 4-12 of the specification); to electrically connect leads to corresponding bonding pads on an integrated circuit using a Tape Automated Bonding (TAB) device (thus, including the use of solder) (see page 2 lines 14-21 of the specification).

In view of the admitted prior art teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Iwasaki '926, the entire outer dimension of the memory module except for the second end of each of the plurality of conductors is surrounded by a covering that employs a mechanical tab which, when actuated, prevents writing data to the integrated circuit, in order to provide the ability to "write protect" the memory module, thereby preventing unintended changes to the data stored in the memory module; and solder extending between a plurality of bonding pads on the integrated circuit and the first end of each of the plurality of conductors; and wherein the plurality of conductors comprise flattened metal strips attributed to a tape mounted upon a Tape Automated Bonding



(TAB) device, in order to use the most efficient and advantageous connection method according to the specific cost constraints and density of the integrated circuit bonding pads of the particular application.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki '926 in view of Eguchi et al (US 2003/0071348 A1).

The teachings of Iwasaki '926 have been discussed above.

Iwasaki '926 fails to specifically teach a surface of the integrated circuit is bonded to a surface of a conductive plate, the opposite surface of the conductive plate extends flush with or beyond the outer dimension of the memory module; wherein the plate is thermally conductive.

Eguchi et al teaches a semiconductor module (see figures 1A and 1B) having an integrated circuit (1) wherein a surface of the integrated circuit is bonded (via resin 5) to a surface of a thermally conductive plate (4), the opposite surface of the conductive plate extends flush with or beyond the outer dimension of the memory module (see figures 1A, 1B, paragraphs 35, 38, and 53).

In view of Eguchi et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Iwasaki '926, a surface of the integrated circuit is bonded to a surface of a conductive plate, the opposite surface of the conductive plate extends flush with or beyond the outer dimension of the memory module; wherein the plate is thermally conductive, in order to help dissipate heat from the memory module, thereby helping to increase the reliability and lifespan of the memory module.

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12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki '926 as modified by Gray (US 6,367,017 B1).

The teachings of Iwasaki '926 have been discussed above.

Iwasaki '926 fails to specifically teach the integrated circuit comprising memory and a memory controller embodied upon a single monolithic silicon substrate.

Gray teaches a memory card comprising a memory and a memory controller embodied on a single chip (see figure 8A and column 13 lines 15-19).

In view of Gray's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Iwasaki '926, the integrated circuit comprising memory and a memory controller embodied upon a single monolithic silicon substrate, in order to reduce the size of the memory module.

13. Claims 13, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki '926 in view of Nishizawa et al (US 6,431,456 B2).

The teachings of Iwasaki '926 have been discussed above.

Iwasaki '926 fails to specifically teach a second integrated circuit stacked upon and bonded to the integrated circuit.

Nishizawa et al teaches a memory module having a second integrated circuit (34b) stacked upon and bonded to (via resin 55) a first integrated circuit (34a) (see figures 5, 6, column 14 line 65 - column 15 line 16, and column 15 lines 63-65).

In view of Nishizawa et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Iwasaki '926, a second integrated circuit stacked upon and bonded to the integrated

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circuit, in order to reduce the distances from the integrated circuits to a controller chip, as compared to the integrated circuits not being stacked (see column 15 lines 4-8, of Nishizawa et al).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kitaoka et al (US 5,523,608) teaches a method for forming a module including clamping conductors between mold housings (see figure 3b). Gokami (JP 2000-194818 A) teaches an IC card including a lead frame having conductors extending between two planes (see figure 1). Matsushita Electronics Corp. (JP 2-177553 A) teaches an IC device having an IC chip bonded to a lead frame and molded with resin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

September 21, 2003

*Jared J. Fureman*  
Jared J. Fureman  
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